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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/425,739	10/22/1999	CHARLES A. PEYSER	07710.0003-0	9954

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/425,739

Applicant(s)

PEYSER ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Claims 1-9 are pending in the instant application.

### ***Claim Rejections - 35 USC §101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

**Claims 1-7 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. "A computer-implemented method for distributing telecommunication services, a computer-

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implemented method for purchasing telecommunication services during a session, etc.”  
mere nominal use of a component, albeit within the technological arts, does not confer  
statutory subject matter to an otherwise abstract idea if the component does not affect  
the underlying process.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that  
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by  
another filed in the United States before the invention by the applicant for patent or (2) a patent  
granted on an application for patent by another filed in the United States before the invention by the  
applicant for patent, except that an international application filed under the treaty defined in section  
351(a) shall have the effects for purposes of this subsection of an application filed in the United States  
only if the international application designated the United States and was published under Article 21(2)  
of such treaty in the English language.

**Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated  
by Mashinsky (U.S. Patent No. 6,226,365 B1).**

Mashinsky discloses a telecommunication providing system and method.

The system comprises a server having access to a memory containing a set of  
responses to purchase request for telecommunication services (col. 9, lines 22-33); and  
a client (col. 22, lines 45-47), connected to the server (col. 22, lines 32-35), for inputting  
a purchase request (col. 11, lines 31-55), accessing the stored set of responses (col.  
22, lines 48-67), and providing an acceptance to the responses (col. 23, lines 7-14).

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The method is disclosed for distributing telecommunication services (col. 2, lines 32-45).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mashinsky (U.S. Patent No. 6,226,365 B1) in view of Ojha (U.S. Patent No. 6,598,026 B1).**

Mashinsky discloses a telecommunication system and method according to claim 1 as indicated supra. Mashinsky does not expressly disclose a system and method comprising denying access by the service providers to the stored set of responses to purchase request for telecommunication service during the session, wherein the response to which access is denied is the same as the response reflecting at least one telecommunication service offering capable of satisfying the requested telecommunication service. The instant invention defines a session as a point in time for considering an offer (page 3 of the instant application as filed). Ojha discloses a system and method comprising denying access by the service providers to the stored set of responses to purchase request for telecommunication service during the session.

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wherein the response to which access is denied is the same as the response reflecting at least one telecommunication service offering capable of satisfying the requested telecommunication service. The seller of Ojma may authorize automated responses to bids by specifying a number of business rules to govern responses. According to Ojma, any number of business rules may be defined by the seller and may be executed in any sequence specified by the seller. For each rule, the seller defines a set of criteria and a set of actions to be taken when the set of criteria is satisfied. Any number of criteria may be defined and combined in a variety of ways using logical operators (e.g., AND, OR, NOT) and groupings. Examples of criteria include (but are not limited to) bid-list spread, product type or group, the number of units, the buyer's reputation, etc. Similarly, any number of actions may be specified. Examples of actions includes (but are not limited to) text responses, ask price reductions, bid acceptance, etc. (Ojma: col. 15, line 31 to col.16, line 4). Once the business rules are stored (Ojma: Fig. 13c) and a buyer makes an offer to the seller, in both the instant invention and Ojma, the rules are automatically implemented on behalf of the seller. The seller would no longer have access or the opportunity to change those rules during the particular negotiation session, wherein as practiced in Ojma the session is practically instantaneous.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Mashinsky to have included the limitations of Ojma as discussed above because there is a demand for technical solutions by which electronic commerce transactions may be facilitated and made more efficient, furthermore it is understood that the ability to identify prices for any two parties

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in an efficient manner would be of potentially great value to both buyers and sellers (Ojma: col. 2, lines 10-25).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-4 and 7-9 filed 29 December 2003 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 5 and 6 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's remarks that "Mashinsky neither teaches nor suggests the presently claimed methods in which (1) the buyer makes a purchase request.....(2) the buyer receives one or more responses from service providers....(3) the buyer has the option of accepting at least one of the responses....".

The Examiner notes that such remarks are not commensurate with the scope of method claims 1-7, and 9. None of these claims recites any step which is performed by any particular party. A "buyer" is never recited. The only recitations to various parties are to "service providers" (claim 1, line 4, for example) and "a requestor" (claim 1, last line, for example). These parties, however, are not recited as actually performing an active step of the methods.

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• Applicant remarks that Mashinsky does not "teach or suggest the claimed systems in which a session is established for a client to input a purchase request, access stored responses, and accept a response during the session".

The Examiner notes that claim 8 is directed to a system and recites, *inter alia*, a client, electronically connectable to the server, to establish a session for (i) inputting a purchase request...(ii) accessing the stored set of responses...(iii) providing an acceptance to the response during the session" (claim 8, last indent). The recitations of subsections (i)-(iii) are considered functional recitations which do not move to structurally distinguish the system of the instant claim from the structure disclosed by Mashinsky '365 B1. Structurally, the Examiner has identified a server having access to a memory (col. 9, lines 22-33), and a client (col. 22, lines 45-47), electronically connectable to the server (col. 22, lines 32-35).

Applicant remarks that "The present claims are directed to a completely different invention by providing methods and systems for purchasing telecommunication services".

The Examiner notes that Mashinsky '365 B1 is not limited to routing calls. Mashinsky '365 B1 also discloses methods and systems for purchasing telecommunication services (see col. 9, lines 22-33; col. 11, lines 31-55; col. 22, lines 48-67; and col.23, lines 7-14).



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• Applicant remarks that "the relied upon portions of the reference do not teach or suggest the present claims".

The Examiner has cited certain passages in order to best exemplify the manner in which the claim recitations "read-on" Mashinsky '365 B1. These passages are not intended to be read in a vacuum. It is the entirety of the Mashinsky '365 B1 disclosure which is relied upon for anticipation of the claims, not simply certain passages alone.

### ***Conclusion***

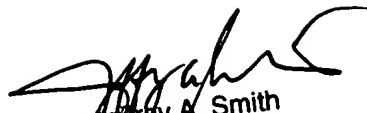
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MSG  
April 28, 2004



Jeffrey A. Smith  
Primary Examiner